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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,759	05/26/2006	Malcolm Bell	020305-004011	9448

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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
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EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2887

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11/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,759	Applicant(s) BELL ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-64 and 66-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-19, 30-36, 40-46, 54-66, 70 and 71 is/are rejected.
- 7) ☒ Claim(s) 20-29, 37-39, 47-53 and 67-69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments/arguments filed on 7/23/2009.
2. Claims 3-64 and 66-71 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

4. Claims 40-42 are objected to because of the following informalities:

Re claims 40-42 (page 8; lines 5, 8, & 10 respectively): there is no antecedent basis for the limitations ‘the RFID device’, ‘the first database’, ‘the second database’, ‘the time’, and ‘the date’. The applicant is respectfully requested to substitute ‘the RFID device’ with ‘an RFID device’, ‘the first database’ with ‘a first database’, ‘the second database’ with ‘a second database’, ‘the time’ with ‘a time’, and ‘the date’ with ‘a date’.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 3-16 and 71 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a machine asserted utility or a well established utility.

Re claims 9 and 71: The claimed limitation recites “means of packaging the container”, “means of sealing the container” and “access to the monetary objects can be obtained only by creating a new opening”. These steps require no specific apparatus and could be done manually unless a specific apparatus is described to performed specific function. Therefore, the examiner finds there is no tie to a specific machine/apparatus and the method does not transform a particular article to a different state or thing (*In re Biliski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

Claims 3-8 and 10-16 are also rejected under 101 as being dependent of claims 9 and 71.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-12, 17-19, 30-33, 35-36, 40-43, 45-46, 54-60, 62-64, 66, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson (U.S. 6,737,974) in view of Freeman (US 2004/0233065).

Re claims 3-12, 17, 35, 40-41, 45, 62, and 71: Dickinson teaches shipping container and system along with shipping method employing the same, which includes a packaging device 10 (col.7, lines 30-67), comprising means for determining first value

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data relating to a sheet object to be stacked in the container 10; and an RF reader/writer {herein scanner receiver} for writing said first value data to an RFID device 80 (col.7, lines 64+), at least one container 10 configured to be filled with a stack of sheet objects by the packaging device (see figs. # 6-7), and a non-reusable closure member {herein interpreted as strip 14 or 54} for providing a one-time seal for the container to confine the stack of sheet objects and the RFID device (see figs.# 2, 8). Dickinson also teaches means of tracking information {herein presence detection with proximity that detect location and piece count} to the RFID device (col.7, lines 40+).

Dickinson fails to specifically teach a reusable RF tag.

Freeman teaches package location system, which includes a reusable or also known in the art as re-programmable RF tag (§ 30, 41-46), and that the RFID is a read-only RFID tag (§ 32).

In view of Freeman's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was done to employ into the teachings of Dickinson a reusable RF tag so as to enable use of the RF tag for further use. Such method would be beneficial in cost-savings for the shipper while increasing the security of the transported and/or shipped items.

Re claims 18, 36: Dickinson teaches system and method, further comprising first processing means having a first database for storing the first value data therein (col.8, lines 20+).

Re claims 19, 46: Dickinson teaches system and method, comprising means of displaying data {herein using computer system} stored in the database to a user (col.10, lines 55+).

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Re claims 30, 43, 57, and 66: Dickinson teaches system and method, comprising an alarm and an RF detector for detecting the RFID device, wherein the RF detector is operable to trigger the alarm in response to detecting the RFID device wherein the packaging device (col.7, lines 35+).

Re claims 31-33, 58-60: Dickinson teaches system and method comprises a sealing device for sealing the container and the RFID device 80 is disposed so as to be sealed inside the container, comprising a closure member to be sealed by the sealing device onto the container, wherein the RFID device is releasably attached to the closure member (see fig.# 6).

Re claim 54: Dickinson teaches system and method, wherein the request signal and/or the data stored in the first database are transmitted over the Internet (col.2, lines 3+).

Re claims 55 and 63: Dickinson teaches system and method, comprising: an RF detector for detecting the RFID device, wherein the RF detector is operable to read the identification information stored on the RFID device and to transmit tracking information to the first processing means, the first processing means being operable to store said tracking information in association with the identification information read by the RF detector in said first database (col.7, lines 40+).

Re claims 42, 56 and 64: Dickinson teaches system and method, wherein the tracking information comprises the time and/or the date *{herein real time scan}* when the RFID is detected by the RF detector (col.10, lines 59+).

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9. Claims 13-16, 34, 44, 61, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson (U.S. 6,737,974) in view of Freeman (US 2004/0233065) as modified above in claim 9, and further in view of Do et al. (U.S. 6,502,746).

The teachings of Dickinson as modified by Freeman have been discussed above.

Dickinson fails to specifically teach monetary objects stacked.

Do et al. teaches device, method and system extracting deposited items from an ATM/CAT safe, which includes a transponder 68 fixed on a deposit bin 36 (col.12, lines 1-55; col.13, lines 5-67).

In view of Do et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was done to employ into the teachings of Dickinson monetary objects in the package for transporting the objects from one place to the other.

Allowable Subject Matter

10. Claims 20-29, 37-39, 47-53, and 67-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to specifically teach means of determining second value data relating to sheet objects removed from the container and a second processing means having a second database for storing the first value data read from the RFID device and the second value data determined by the unpacking device. These limitations

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in conjunction with other limitations in the claimed invention were not shown by the prior art of record.

Response to Arguments

12. Applicant's arguments with respect to claims 3-64 and 66-71 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571)272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EDWYN LABAZE/
Primary Examiner, Art Unit 2887